

Remarks/Arguments

This Amendment includes a Change of Correspondence Address.

This Amendment includes a Petition to extend the term for response by three months from 02/16/2006 to 05/16/2006.

Status of the Application:

Status of the Drawings:

The Examiner is requested to acknowledge acceptance of the drawings as filed.

Status of the Information Disclosure Statement:

The Examiner is requested to acknowledge the timely submission of an Information Disclosure Statement filed 06/15/2000 (the filing date of the application).

Enclosed herewith is a further Information Disclosure Statement.

Status of the Claims:

Claims 1, 3, 5, 7, 9, 11 and 12 pending in the application. Claims 1, 3, 7, 11 and 12 are rejected under 35 USC 102(e) as anticipated by Yanof et al., US 5,734,384; claim 5 is rejected under 35 USC 103(a) as being unpatentable over Yanof et al. in view of Bamberger, US 5,970,164; claim 9 is rejected under 35 USC 103(a) as being unpatentable over Yanof et al. in view of Endo et al., US 6,169,552. No claim is allowed or is indicated as reciting allowable subject matter.

Status of the Detailed Description:

No objection has been made to the Detailed Description, i.e., the specification. The Detailed Description has been amended in the following respects for the following reasons. Page 1 has been amended to recite in the CROSS-REFERENCE TO RELATED APPLICATIONS the priority to French patent application 99 07854 filed June 21, 1999. The notes that the Examiner has acknowledged in paragraph 2 on page 2 the priority claim. Pages 2 and 4 have been amended to more properly, appropriately and correctly locate the indication of the applicable application section. Pages 2, 3, 4, 5 and 6 have been amended to correct informalities, grammatical expression and typographical

errors in the application. No new matter is introduced by the amendments to the Detailed Description.

Rejection of Claims Under 35 USC 102(e)

Claims 1, 3, 7, 11 and 12 are rejected under 35 USC 102(e) as anticipated by Yanof et al., US 5,734,384. It is well-settled patent law that a rejection of a claim as anticipated under 35 USC 102 requires that each and every element or feature recited in the claim must be either explicitly disclosed or taught by a single cited reference or be reasonably understood by one skilled in the art from the teachings of the cited reference. See, for example: “[T]he dispositive question regarding anticipation [I]s whether one skilled in the art would reasonably understand or infer from the [prior art reference’s] teaching that every claim element was disclosed in that single reference. In re Baxtor Travenol Labs, Inc., 952 F2d 388, 390, 21 USPQ2d 1281, 1284 (Fed. Cir. 1991); see also Schumer v. Lab. Computer Sys., Inc. 308 F2d 1304, 1315, 64 USPQ2d 1832, 1841 (Fed. Cir. 2002); and “‘To serve as an anticipation when the reference is silent about an asserted inherent characteristic, such a gap in the reference may be filled with recourse to extrinsic evidence [; however, s] uch evidence must make clear that the missing descriptive subject matter is necessarily present in the thing described in the reference’”. Cont’l Can Co USA v. Monsanto Co., 948 F2d 1264, 1268, 20 USPQ2s 1746, 1749 (Fed.Cir. 1991) cited with approval in Dayco Products, Inc., Total Confinement, Inc. 329 F.3d 1358, 66 USPQ 2d 1801 (CAFC, May 23, 2003).

Accordingly, the applicant traverses the rejection of claim 1 and dependent claims 3, 7, 11 and 12 as being anticipated under 35 USC 102(e) by Yanof et al. for the following specific reasons. Generally, it may be noted that the teachings of Yanof et al. is essentially described by the applicant in the application as filed as known in the prior art.

Claim 1 further recites a method, inter alia a defined sequence of steps, comprising display, selecting a point on an element of interest, creating in a part of the image a predetermined volume whose center is the point, making an interactive intersection between the volume and the part of the image to isolate the element of interest in the image, and visualizing only the part contained in the volume. The applicant

does not believe that Yanof et al. teaches the method as recited in claim 1 and does not believe the observations made by the Examiner regarding the method are an anticipation of the method as claimed.

Yanof et al., in Figure 2 at item 22 does not display a three-dimensional image as alleged by the examiner. Figure 2, at item 22 is a selected two-dimensional image. Claim 1 recites “displaying the three-dimensional image”.

Yanof et al. does not next and thereafter make a selection of a point of interest, and as recited by claim 12 by a cursor. Reference 46a in Yanof et al. is not a “selection” as recited in claim 1 but only a view direction (see col. 6, line 49) and only provides a shift or translation of region 36.

There is no teaching in Yanof et al. of an interactive intersection to cause the isolation of the element of interest in the predetermined volume of the image as recited in claim 1. The several views in Figure 2 of Yanof et al. are different views along different selected axes but still result in an occluded view of the blockage 36, see for example, view port 46.

Yanof et al. fails to teach creating in a part of the image a predetermined volume whose center is the point for the same reasons as noted above as recited particularly in claim 3.

The applicant does not find in the cited Yanof et al. the features of claims 3, 7 and 11 in the manner recited by the Examiner in paragraphs 6, 7 and 8 of the Office communication.

Finally, there is no teaching in Yanof et al. of the visualization step as recited in claim 1, i.e., visualizing *only the part contained in the volume* (emphasis added).

Claim 1 has been amended to recite with greater particularity the elements or features of the method to further patentably distinguish over Yanof et al.

Accordingly, the applicant believes that claim 1 and dependent claims 3, 7, 11 and 12 recite patentable and allowable subject matter. The Examiner is respectfully requested to advise the applicant that claims 1, 3, 7, 11 and 12 are allowable.

Rejection of Claims Under 35 USC 103(a)


Claim 5 is rejected under 35 USC 103(a) as being unpatentable over Yanof et al. in view of Bamberger, US 5,970,164; claim 9 is rejected under 35 USC 103(a) as being unpatentable over Yanof et al. in view of Endo et al., US 6,169,552. The rejection of dependent claims 5 and 9 is traversed for the same reasons as claims 1, 3, 7, 11 and 12 inasmuch as Yanof et al. is the basis for the rejection and regardless of the alleged teaching of Bamberger or Endo et al.

The applicant further notes that a rejection under 35 USC 103 essentially requires an examination of the claim as a whole and not merely the finding of an alleged teaching in the prior art of one claim feature or element and a conclusion that it is obvious for one skilled in the art to combine the references. The Court of Appeals for the Federal Circuit has repeatedly held that a rejection under 35 USC 103 must satisfy the criteria of *Graham vs. Deere*. The rejection has failed to satisfy these criteria, particularly of how the features and functions as recited in the claims can be found in the cited reference and how any differences between the features and functions are obvious to one skilled in the art. It is not sufficient to merely conclude that the one skilled in the art *could* modify or adapt the cited prior art to therefore read on the features and functions recited in the claims. The Examiner must establish that one skilled in the art *would* modify or adapt the cited prior art and demonstrate the motivation or nexus of the prior art to the features and functions recited in the claims. The Examiner has alleged that the claimed invention is obvious based on a combination of prior art references. It is improper hindsight merely to “pick and choose” features from the prior art references to “arrive” at the invention as claimed. There must be a non-speculative and objective suggestion or motivation in one or more of the cited prior art to combine the features of the prior art in the manner recited in the invention as claimed. A prima facie of unpatentability is not established by speculating that any claim feature is found in the cited prior art simply because the word “comprising” is recited in the claim. Without this suggestion or motivation or non-speculative indication in the cited prior art the invention as claimed is unobvious and patentable in accordance with 35 USC 103.

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Docket No. 14XZ87 (GEM-0277)

Accordingly, the applicant believes that dependent claims 5 and 9 recite patentable and allowable subject matter. The Examiner is respectfully requested to advise the applicant that claims 5 and 9 are allowable.

Respectfully submitted,
BETTING ET AL.

By _____

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